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#### REMARKS

This Amendment is submitted in response to the Office Action mailed on May 3, 2007. Claims 148 - 198 are pending.

Claims 148 - 156, 162 - 170, 178, and 179 are allowed.

Claims 160, 161, 174, 175, and 177 are objected to. It is believed that amendments have removed the grounds for objection.

Claims 157 - 159, 171 - 173, 176, and 180 - 198 are rejected.

Claim 199 is added.

No fee is due for either the added claim 199, or for the previously dependent claims which have been amended into independent form.

Amendments to claim 192 correct obvious typographical errors.

#### RESPONSE TO 102 - REJECTION OF CLAIM 188

Claim 188 was rejected as anticipated by Korman. Claim 188 recites:

188. A method of operating a server system and associated ATMs, comprising:

a) querying the ATMs over a network, to obtain information about conditions in the ATMs;

b) based on the information, making predictions as to times when specific maintenance procedures should be performed on the ATMs; and

c) scheduling maintenance personnel to perform the procedures.

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**Korman not Available as Reference**

Applicant points out that the Korman '887 reference is not available as prior art. Three dates are involved in Korman:

Korman's U.S. filing date of July 2, 1999,

Korman's PCT filing date of December 2, 1998, and

Korman's Provisional filing date of December 2, 1997 (one year prior to the PCT date.)

The earliest possible filing date available to Korman is his PCT filing date. Since Applicant's foreign priority date, namely, July 25, 1998, is prior to Korman's PCT filing date, Korman cannot be used as a reference. This will be explained.

The relevant rule is found in MPEP § 706.02(b), page 700-24, left column, second paragraph (Rev. 2, May, 2004). The rule is this:

No international filing dates prior to November 29, 2000, may be relied upon as a prior art date under 35 U.S.C. 102(e) . . .

This rule precludes use of Korman. The rule further prohibits use of the earliest date in Korman, namely, the provisional date:

**Patents** issued directly, or indirectly, from international applications filed before November 29, 2000, may only be used as prior art based on the provisions of 35 U.S.C. 102(e) in effect before November 29, 2000.

Thus, the 35 U.S.C. 102(e) date of such a

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prior art patent is the earliest of

the date of compliance with 35 U.S.C.  
371(c)(1), (2), and (4),

or

the filing date of the later-filed U.S.  
continuing application that claimed the  
benefit of the international application.

In this rule, "the date of compliance with 35 U.S.C.  
371(c)(1), (2), and (4)" refers to the completion of formal  
requirements for entry into the "national stage." Since the  
earliest possible date for that completion is the PCT filing date,  
the earliest effective date of Korman '887 is his PCT filing date.

As stated above, Applicant's foreign priority date precedes  
that PCT date. Therefore, Korman is not available as prior art.

This conclusion is confirmed by the MPEP's EXAMPLE 6, found  
on page 700 - 33. In EXAMPLE 6, an International Application, IA,  
was filed in Canada on January 1, 2000, that is, prior to November  
29, 2000. The MPEP states (last two paragraphs):

If the IA properly claimed priority/benefit to  
any earlier-filed U.S. application (whether  
provisional or nonprovisional)

. . .

[then]

the 35 U.S.C. 102(e) date for the patent will  
still be 01 July 2002 (the date of fulfillment  
of the requirements under 35 U.S.C. 371(c)(i),  
(2), and (4)).

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If a later-filed U.S. nonprovisional . . . application claimed the benefit of the IA in the example above, . . . the 35 U.S.C. 102(e) date of the patent of the later-filed U.S. application would be 01 July 2002 (the date that the earlier-filed IA fulfilled the requirements of 35 U.S.C. 371(c)(1), (2), and (4)).

Therefore, Applicant submits that EXAMPLE 6 is directly on-point. The filing date of the IA in EXAMPLE 6 corresponds to the PCT filing date of Korman. The MPEP, in EXAMPLE 6, states that no benefit of an earlier provisional is available.

Consequently, the earliest possible effective date of Korman is the PCT filing date. As stated above, Applicant's foreign priority date precedes that. Korman cannot be used as a reference.

These arguments were made in Applicant's previous Amendment, mailed on August 23, 2004. The subsequent Office Action, mailed on February 9, 2005, apparently agreed with Appellant's arguments regarding Korman, because that subsequent Office Action relied on new references.

Since all rejections rely on Korman, Applicant submits that they cannot stand.

#### **Korman does not Show claim 188**

##### Point 1

The claim states that a "server" makes the "prediction" "based

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on" "information" obtained from the ATMs.

Even if Korman shows the "prediction" (which is not so), his ATM makes that supposed prediction, not any "server" as claimed.

That is, column 9, lines 56 - 58, which are used to show the "prediction," expressly states that Korman's ATMs are "polled" for "data such as when components need service."

Thus, Korman's ATMs state, in response to the "poll," when the service is needed.

That does not correspond to the claimed "prediction" **made by a "server"**, based on "information" from the ATMs.

#### Point 2

Claim 188(b) states "making predictions as to times when specific maintenance procedures should be performed on the ATMs."

The "times" "predicted" clearly refer to **future dates** (or times). That is, a **future date** (or time) is **derived**, such as "December 20, 2007."

Korman does not show that. The Office Action relies on Korman, column 9, lines 56 - 58. However, the "polling" in that passage clearly means that ATMs are asked, for example, when certain supplies have run low. Plainly, when a lower threshold in supplies is reached, Korman schedules a replenishment.

For example, Applicant assumes that, if an ATM's cash dispenser reaches a supply of \$ 5,000.00, and reports that fact

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when "polled," then Korman schedules a replenishment.

That is different from, for example, the claimed server learning that the ATM's cash dispenser reaches that same supply of money, **and then predicts that service is necessary by a certain date.**

Stated more simply, when Korman's ATM, in answering a "poll," states that supplies have reached a lower limit, Korman then schedules replenishment. But the date of that replenishment does not correspond to the "predicted" "times."

Added dependent claim 199 emphasizes this point, but is seen as not necessary, in view of the discussion above.

**RESPONSE TO 103 - REJECTIONS OF CLAIMS  
180, 181, 190, 195, AND 196**

**Point 1**

As explained above, Korman is not available as a reference.

**Point 2**

All these claims recite a "list" (of service personnel, for example).

That "list" has not been shown in the prior art.

MPEP § 2143.03 states:

To establish prima facie obviousness . . . **all the claim limitations** must be taught or suggested by the prior art.

### Point 3

No valid teaching has been given for combining Korman with a "list" (which was **not shown** in the prior art).

The rationale given is that "end users" will **save time** because of information on the list. However, several problems exist in this rationale.

#### Problem 1

No basis of comparison is given which allows one to determine whether, in fact, "time" will be "saved." That is, with what is the process in the combined references compared, to determine whether time is, in fact, "saved" in the combination ?

If no basis of comparison is given, then one cannot determine whether the Office Action's assertion of time-saving is true.

If one cannot determine the truth or falsity of a statement, then the statement cannot be used.

#### Problem 2

No evidence has been given showing that time, in fact, is saved. Evidence is required.

#### Problem 3

The Office Action compares apples with oranges. Under the

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claims, a computer uses the "list." Plainly, the computer is probably faster than a human in locating a person on the list.

However, it costs money to (1) buy the computer and (2) program it, etc.

Thus, it is not rational to compare computerized operation with human-based operation of a task, and to say that the computerized operation is preferable, based on time saving. Numerous other factors are involved, which may outweigh any saving in time.

#### Problem 4

The supposed saving in time is merely a supposed characteristic of the combination of elements, once combined. But that is not a teaching for making the combination in the first place.

If it were a teaching, then every invention ever made would be obvious. The reason is that every invention has some type of characteristics. The mere presence of characteristics in an invention, or combination of references, does not show obviousness.

#### Problem 5

As just explained, the Office Action relies on a characteristic of a combination of elements to show that the combination is obvious.



However, the combination has numerous characteristics. To rely on the characteristic chosen (supposed time-saving), Applicant submits that the PTO must show a teaching which suggests that time-saving trumps the other characteristics as to desirability.

#### Problem 6

Time saving cuts both ways. For example, a dentist can save time by eliminating anaesthesia. But that is clearly not desirable for many patients.

The dentist can also save time, by hastening each procedure. But that would promote errors.

Therefore, Applicant submits that the saving of time is a two-edged sword, which is not a goal to be blindly pursued. The PTO must show that the saving of time has no deleterious consequences which outweigh any saving.

#### Problem 7

The rationale does not follow the CAFC's decision of In re Dembiczak, 175 F. 3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999).

In brief, Dembiczak states that

- **objective evidence** of a teaching for combining references must be provided;
- the Examiner's speculation does not qualify as objective evidence;

- numerous sources can provide a teaching to combine references;
- knowledge of one skilled in the art can act as a source;
- however, THE RANGE OF SOURCES AVAILABLE DOES NOT DIMINISH THE REQUIREMENT FOR ACTUAL EVIDENCE;
- broad conclusory statements by the Examiner do not qualify as evidence; and
- "particular factual findings" as to the teaching are required, and gives reasons why **facts** are necessary.

Applicant submits that no "objective evidence" nor "facts" have been given. Further, it appears that the rationale is a "broad conclusory statement" which is specifically prohibited by Dembiczak.

#### **Point 4**

Claim 180 recites not merely a "list," but "apparatus" which uses the list in a particular way. That has not been shown in the prior art.

Further, claim 180 states that the "list" is "maintained" in "each ATM." That has not been shown in the prior art. The Office Action simply refers to a supposed "list." But that could be a

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list within a clerk's desktop PC.

This applies to the other claims in this group.

**RESPONSE TO 103 - REJECTIONS OF CLAIMS  
182, 183, 197, AND 198**

**Point 1**

The discussion of the parent claims applies here. Korman is not available as a reference.

**Point 2**

Claim 182 states that the technicians on the "list" are "ranked."

Lesaint states that a **ranking** as to priority is done by scheduler 30. (Column 13, line 10 et seq.) However, that scheduler 30 is part of computer X in his Figure 1. That computer X schedules "tasks" J1, J2, etc., which are transmitted to technicians T1, T2, etc., over hand-held computers H1, H2, etc. (Column 6, lines 53 - 63, et seq.)

Claim 182, when read with its parent claim, states that the **ATM** (which experiences the malfunction which the technician is to fix) stores the "list" of "ranked" technicians. And the ATMs makes the requests for maintenance.

The PTO has provided no explanation as to why the **single** computer X in Lesaint should correspond to the claimed ATMs, and

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why the process of **single** computer X in Lesaint should be replicated in the **multiple claimed** ATMs.

### Point 3

No valid teaching has been given for combining the references. It appears that providing "better customer satisfaction" is the rationale for combining the references.

But that is not a valid teaching under section 103. That is merely a supposed characteristic of the references, once combined. And no evidence has been given showing that the satisfaction is actually improved.

Further, no showing has been made that "customer satisfaction" is even relevant. The combined inventions relate to **maintenance of machines**. Customers may use the machines, but they, in general, do not care about the details of the maintenance.

The PTO must show that (1) the customers somehow detect the change in maintenance procedures in the combined references and (2) the customers' "satisfaction" is thereby improved.

### RESPONSE TO 103 - REJECTIONS OF CLAIMS 157 - 159, 171 - 173, 176, 179, 184 - 187, 189, AND 191 - 194

### Point 1

As explained above, Korman is not available as a reference.

**Point 2**

The claimed operation of the intelligent agents has not been shown in the references, even if combined.

Agarwal is cited as showing intelligent agents. But the Office Action states that the agents are "located on each client and server."

The claims do not say that. Claims 157, 171, and 184 state, for example, that the agents **move around the network**. That has not been shown in Agarwal.

Applicant requests that, under 37 CFR §§ 1.104(c)(2) and 35 U.S.C. § 132, that, for the independent claims in this group, the PTO specifically identify the following claim recitations in the references:

Claim 157(a), (b), and (c);

Claim 171(b), (c), and (d);

Claim 176(a), (b), and (c); and

Claim 193(b)(ii), and the causal relation recited in the claim.

**Point 3**

Even if the references are combined, the claims are not attained, for a second reason.

Independent claim 157 states "wherein all intelligent agents share a common data format." Claim 171 contains a similar recitation.

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That has not been shown in the references, even if combined.

#### Point 4

No valid teaching has been given for combining the references.

The rationale given by the Office Action on page 5 merely sets forth supposed characteristics of the combined references.

That is not a teaching.

#### RESPONSE TO ALL OBVIOUSNESS REJECTIONS

MPEP § 706.02(j) states:

Contents of a 35 U.S.C. 103 Rejection

. . . .

To establish a prima facie case of obviousness, three basic criteria must be met.

First, there must be some **suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

. . . .

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

None of the rejections provide a "teaching or suggestion"

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which is found in the prior art.

#### CONCLUSION

Applicant requests that the rejections to the claims be reconsidered and withdrawn.

Applicant expresses thanks to the Examiner for the careful consideration given to this case.

Respectfully submitted,

  
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